



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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D.A. Thomas – Deputy General Counsel
Bridgestone/Firestone, Inc.
1200 Firestone Parkway
Akron, OH 44317

In re Application of :
Donald R. Russell et al. :
Serial No. 09/505,052 : DECISION ON PETITION
Filed February 16, 2000 :
For: SELF-ADHERING WALKWAY PADS:
FOR ROOFING MEMBRANES AND :
METHOD FOR THE APPLICATION :
THEREOF TO ROOFS :

This is in response to applicants' petition under 37 CFR 1.181 filed January 28, 2002 requesting withdrawal of the finality of the Office action mailed November 27, 2001 as being premature.

The Petition is **DENIED**.

Applicants allege that the final rejection was premature because all the grounds of rejection were different than the rejections in the previous Office action and that the nature of the amendments were minor and did not require new grounds of rejection.

MPEP 706.07(a) sets forth that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new ground of rejection that is neither necessitated by the applicants' amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

A review of the record reveals that a first Office action was mailed on March 14, 2001 wherein all claims 1-7 were rejected under 35 USC 102(b) as anticipated by Davis et al. In response thereto an amendment was filed July 16, 2001. This amendment amended claim 1 as follows. The phrase "affixing.....solids tape to one flat surface of a walkway pad, prior to use in the field, ..." was deleted and "affixing.... solids tape to one flat surface of a walkway pad..., and where said step of affixing occurs at the location where the pad is manufactured" was added. "Prior to use in the field" is a different limitation than "where the pad is manufactured" especially in view of the fact that the claim is a method claim. In response to this amendment, the examiner issued a final rejection mailed November 27, 2001. The final rejection contained all new rejections including a new rejection of claim 1 under 35 USC 102(b) as anticipated by Shepherd. This reference was used since it disclosed the step of affixing a tape "at the manufacturing location" the newly added limitation to claim 1.

Clearly the examiner changed her rejection of the claims, and specifically claim 1 in response to applicant's amendment to the claim wherein the newly added language set forth limitations not previously claimed. The finality of the Office action is deemed appropriate and for this reason the petition is denied.

It is noted that an amendment after final rejection was filed January 28, 2002. This application is being forwarded to the examiner of record for consideration of that amendment.

Summary: Petition DENIED.



Anthony Knight, Acting Director
Technology Center 3600

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ak/kd: 03/14/02

